I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: February 20, 2008 Signature: /Jacob G. Weintraub/
Jacob G. Weintraub, Reg. No.: 56,469

Docket No.: 60008US(49991)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Claude R. Mallet et al.

Application No.: 10/516,419 Confirmation No.: 4959

Filed: August 29, 2005 Art Unit: 1657

For: DESTRUCTIBLE SURFACTANTS AND USES THEREOF Examiner: R. J. Gitomer

AMENDMENT AFTER FINAL ACTION UNDER 37 C.F.R. 1.116

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

In response to the final Office Action dated November 20, 2007, please amend the above-identified U.S. patent application as follows:

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

Claims 1-16 are pending in the instant application. The pending claims have not been amended, and accordingly, claims 1-16 will remain pending upon entry of the instant remarks/arguments into the record. *No new matter has been added*.

Applicants note that a Supplemental IDS has been provided herewith to satisfy Applicants' continuing duty of disclosure. In addition, Applicants provide herewith a copy of cited reference CG of Applicants IDS submitted on December 22, 2005. It had been noted at such time that Applicants were in the process of obtaining this reference. Upon review of Applicants records, it is unclear whether this reference had previously been provided, and therefore, Applicants provide this reference herewith as a convenience.

Moreover, amendment and/or cancellation of the claims during pendency of the application are not to be construed as acquiescence to any of the objections/rejections set forth in any Office Action, and were done solely to expedite prosecution of the application. Applicants submit that claims were not added or amended during the prosecution of the instant application for reasons related to patentability. Applicants reserve the right to pursue the claims as originally filed, subsequently amended or added, or similar claims, in this or one or more subsequent patent applications.

Claims Rejections – 35 U.S.C. §103

Claims 1-16 remain rejected under 35 U.S.C. §103(a) as being unpatentable over each of Ross et al. (July 2002) and Lee et al. (WO 00/70334). Moreover, the Office Action, on page 3, now suggests that "Ross (Proteomics) published online July 12, 2002…" is "…reporting the proceedings of the 1st Annual conference of the Swiss Proteomics Society held November 21-22, 2001…" Applicants again respectfully disagree and traverse this rejection.

First, it is not clear from the record, exactly how the Examiner has concluded that "Ross (Proteomics) published online July 12, 2002" is "reporting the proceedings of the 1st Annual conference of the Swiss Proteomics Society

held November 21-22, 2001." The Examiner has not provided any evidence that Ross et al. even presented at the Swiss Proteomics Society. Applicants suggest that Ross et al. may merely have submitted an article for submission for publication in the journal Proteomics, without an accompanying presentation.

Even assuming *arguendo* that such presentation occurred, Applicants respectfully assert that there is no evidence in the record or in the art that the content of any proceedings of Ross in November of 2001 match the publication published in July of 2002. In this regard, Applicants submit that it is very typical for ongoing data and conclusions to be added to subsequent publications after the date of presentation at meetings (particularly given that submissions for that Proteomics publication were due by December 15, 2001, roughly a month after the meeting, as noted on the Swiss Proteomics Society website). Without such evidence of identity, Applicants assert that the citation of Ross et al. publication is improper.

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Furthermore, Applicants respectfully remind the Examiner that in order to qualify as prior art under 35 U.S.C. § 103, the reference must qualify as prior art citable under 35 U.S.C. § 102. In this regard, Applicants respectfully invite the Examiner's attention to M.P.E.P. § 2132.35 (a) and 35 U.S.C. § 102(a). For convenience, Applicants provide the relevant text of 35 U.S.C. § 102(a) which states:

> A person shall be entitled to a patent unless -
> (a) the invention was known or used by others **in this country**, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent (Emphasis added).

Moreover, M.P.E.P. § 2132.35 (a) affirms that

> The knowledge or use relied on in a 35 U.S.C. 102(a) rejection must be knowledge or use "**in this country**." ***Prior knowledge or use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under 35 U.S.C. 102(a)***. *In re*

> *Ekenstam*, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). Note that the changes made to 35 U.S.C. 104 by NAFTA (Public Law 103-182) and Uruguay Round Agreements Act (Public Law 103-465) do not modify the meaning of "in this country" as used in 35 U.S.C. 102(a) and thus "in this country" still means in the United States for purposes of 35 U.S.C. 102(a) rejections (Emphasis added).

Accordingly, in order to qualify as prior art under 35 U.S.C. § 103, the reference must have been known or used by others **in this country**, or patented or described in a printed publication in this or a foreign country. The cited art is not patented or described in a printed publication that would qualify as prior art under 35 U.S.C. § 102 (a).

Moreover, the first scientific meeting of the ***Swiss*** Proteomics Society, was held in Geneva, ***Switzerland*** on November 21– 22, 2001. Geneva is not "in the United States," and as such (regardless of whether the Examiner is persuaded by Applicants' comments above regarding the connection, or lack thereof, between the hypothetical presentation and the cited publication), it is quite clear that Ross et al. does not qualify as a 102(a) reference as of the date of the ***Swiss*** Proteomics Society meeting on November 21-22, 2001. Therefore, Ross et al would also not qualify as a 103(a) reference as of the date of the ***Swiss*** Proteomics Society meeting on November 21-22, 2001.

Accordingly, Applicants reiterate their prior arguments with regard to Ross et al.. We again respectfully remind the Examiner of the acknowledged and accepted claim for the benefit of priority of provisional application No. 60/385,018, filed on **May 31, 2002**. Applicants assert that this date of priority clearly precedes Ross et al., which was published on ***July 12, 2002***. As such, the rejection of claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Ross et al. is inappropriate.

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With respect to Lee et al., the prior office Action referenced page 5, lines 15-18, which recites that "the present invention is useful for the solubilization, analysis, separation, purification and/or characterization of large molecules." However, the prior office Action suggested on page 4 that

> [i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the surfactant taught by each of Ross and Lee to analyze small molecules ***because the references teach digests of large molecules which are then analyzed where such digests form small molecules that are analyzed***. It is shown that it is desirable to use the presently elected surfactant to improve the analysis of the digests ***[Emphasis Added]***.

The prior office Action used this suggestion as the sole support for the rejection of claims 1-16 as obvious in light of the cited art; concluding that there is only minimal distinction between "the references which teach the presently claimed method for 'samples' and show examples of digested proteins analyzed vs. the present claims which are directed to analysis of 'small molecules.'"

Applicants respectfully disagreed, and requested that the Examiner explicitly indicate the passage to which he was referring. In response, the Examiner has indicated that on "page 6, line 32 MALDI is an example of mass spec described where MALDI digests the sample." Applicants submit that the Examiner has a fundamental misunderstanding of the processes and differences of fragmentation and of digestion of a protein or peptide. The term "digestion," in reference to protein analysis, would be understood by the ordinarily skilled artisan as a breaking down of a protein through the use of enzyme cleavage. In contrast, the breaking down of a protein during MALDI analysis is referred to as fragmentation, which through the use of high energy bombardment produces molecular ions to which a magnetic field is applied to separate the ions based on mass-to-charge ratios; **which is certainly not the same thing as digestion**.

Applicants again assert that ***Lee et al. does not teach or suggest the analysis of "digests" of large molecules***. In view of this lack of support, the Applicants further contend the validity of the conclusions reached by the Office Action, and respectfully ask for reconsideration in light of the comments made herein.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-16 under 35 U.S.C. §103(a), and favorable reconsideration.

CONCLUSION

In view of the foregoing, reconsideration and withdrawal of all rejections, allowance of the instant application with all pending claims, and passage of the instant application to issuance are earnestly solicited. If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at the telephone number below.

Applicants believe that there are no fees due with this response. However, if a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 04-1105 for any fee(s) due with this response.

Dated: February 20, 2008

Respectfully submitted,

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